RECORD AND BRIEFS

Supreme Court, U.S.
FILED
NOV 9 - 2016
OFFICE OF THE CLERK

No. 15-1293

In the Supreme Court of the United States

MICHELLE K. LEE, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE, PETITIONER

v.

SIMON SHIAO TAM

ON WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

JOINT APPENDIX

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PETITION FOR A WRIT OF CERTIORARI FILED: APR. 20, 2016
CERTIORARI GRANTED: SEPT. 29, 2016

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UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

Docket No. 14-1203

IN RE: TAM

SIMON SHIAO TAM, APPELLANT

v.

MICHELLE K. LEE, DIRECTOR, U.S.
PATENT AND TRADEMARK OFFICE, APPELLEE

DOCKET ENTRIES

DATE	DOCKET NUMBER	PROCEEDINGS
1/7/14	1	Appeal docketed. Date received: 01/02/2014. [127523] Entry of Appearance due 01/21/2014. Certificate of Interest is due on 01/21/2014. Docketing Statement due 02/06/2014. Appellant/Petitioner's brief is due 03/10/2014.
		* * * * *
1/23/14	20	Certificate of Interest for the Appellant Simon Shiao Tam. Service: 01/23/2014 by email. [131094]
1/23/14	21	Docketing Statement for the Appellant Simon Shiao Tam. Service: 01/23/2014 by email. [131095]

DATE	DOCKET NUMBER	PROCEEDINGS
		* * * * *
2/6/14	24	Docketing Statement for the Appellee Lee. Service: 02/06/2014 by US mail, email. [134255]
		* * * * *
4/21/14	28	BRIEF FILED for Appellant Simon Shiao Tam [27]. Title: Brief on Behalf of Appellant, [Non-Confidential version only]. Number of Pages: 57. Service: 04/21/2014 by email. Pursuant to ECF-10, filer is directed to file six copies of the brief in paper format. The paper copies of the brief should be received by the court on or before 04/28/2014. Appellee Michelle K. Lee, Deputy Director, U.S. Patent and Trademark Office brief is due 06/05/2014. [149556]
		* * * * *
8/4/14	36	BRIEF FILED for Appellee Lee [35]. Title: OPENING BRIEF. Number of Pages: 40. Service: 08/04/2014 by email. Pursuant to ECF-10, filer is directed to file six copies of the brief in paper format. The paper copies of the brief should be received by the court on or before 08/11/2014. Appellant Simon Shiao Tam reply brief is due 08/21/2014. [172949]

DATE	DOCKET NUMBER	PROCEEDINGS
		* * * * *
9/23/14	43	BRIEF FILED for Appellant Simon Shiao Tam [42]. Title: REPLY BRIEF. Number of Pages: 28. Service: 09/23/2014 by email. Pursuant to ECF-10, filer is directed to file six copies of the brief in paper format. The paper copies of the brief should be received by the court on or before 09/29/2014. Appendix is due 10/03/2014. [185043]
		* * * * *
10/1/14	46	APPENDIX FILED for Simon Shiao Tam [45]. Title: JOINT APPENDIX. Number of Pages: 352. Service: 10/01/2014 by email. Pursuant to ECF-10, filer is directed to file six copies of the brief in paper format. The paper copies of the brief should be received by the court on or before 10/07/2014. [187116]
		* * * * *
1/9/15	51	Submitted after ORAL ARGUMENT by Ronald D. Coleman, Esq. for Simon Shiao Tam and Ms. Molly R. Silfen for Lee. Panel: Judge: Lourie, Judge: Moore, Judge: O'Malley. [208419]
		* * * * *

DATE	DOCKET NUMBER	PROCEEDINGS
4/20/15	53	OPINION and JUDGMENT filed. The judgment or decision is: Affirmed. (Precedential Opinion). (For the Court: Lourie, Circuit Judge; Moore, Circuit Judge and O'Malley, Circuit Judge). Moore, Circuit Judge, additional views. [234068] Vacated pursuant to the court's order. See Doc No. [54]
4/27/15	54	PRECEDENTIAL ORDER filed vacating the opinion Precedential Opinion [53]; reopening appeal; additional briefing ordered Appellant/ Petitioner's brief is due 06/11/2015; en banc rehearing. By: En Banc (Per Curiam). Service as of this date by Clerk of Court. [235778]
		* * * * *
6/11/15	65	BRIEF FILED for Appellant Simon Shiao Tam [64]. Number of Pages: 30. Service: 06/11/2015 by email. Pursuant to ECF-10, filer is directed to file six copies of the brief in paper format. The paper copies of the brief should be received by the court on or before 06/17/2015. Appellee Michelle K. Lee, Director, U.S. Patent and Trademark Office brief is due 07/16/2015. [247711]
		* * * * *

DATE	DOCKET NUMBER	PROCEEDINGS
6/18/15	93	AMICUS BRIEF FILED for International Trademark Association [70]. Number of Pages: 23. Service: 06/18/2015 by email. Pursuant to ECF-10, filer is directed to file six copies of the brief in paper format. The paper copies of the brief should be received by the court on or before 06/24/2015. [249867]
6/18/15	94	AMICUS BRIEF FILED for Public Knowledge [78]. Number of Pages: 20. Service: 06/18/2015 by email. Pursuant to ECF-10, filer is directed to file thirty copies of the brief in paper format. The paper copies of the brief should be received by the court on or before 06/24/2015. [249884]
6/18/15	96	AMICUS BRIEF FILED for Pro-Football, Inc. [79]. Number of Pages: 35. Service: 06/18/2015 by email. Pursuant to ECF-10, filer is directed to file thirty copies of the brief in paper format. The paper copies of the brief should be received by the court on or before 06/24/2015. [249906]

DATE	DOCKET NUMBER	PROCEEDINGS
6/18/15	106	AMICUS BRIEF FILED for Cato Institite and The Rutherford Institute [89]. Number of Pages: 31. Service: 06/18/2015 by email. Pursuant to ECF-10, filer is directed to file thirty copies of the brief in paper format. The paper copies of the brief should be received by the court on or before 06/29/2015. [250399]
6/18/15	107	AMICUS BRIEF FILED for First Amendment Lawyers Association [90]. Number of Pages: 15. Service: 06/18/2015 by email. Pursuant to ECF-10, filer is directed to file thirty copies of the brief in paper format. The paper copies of the brief should be received by the court on or before 06/29/2015. [250408]
		* * * * *
6/18/15	120	AMICUS BRIEF FILED for Hugh C. Hansen [117]. Number of Pages: 16. Service: 06/18/2015 by US mail. Pursuant to ECF-10, filer is directed to file thirty copies of the brief in paper format. [250883] This brief has been corrected. See Doc No. [123]
		* * * * *
6/22/15	105	ORDER filed scheduling oral argument. Oral argument en banc for

DATE	DOCKET NUMBER	PROCEEDINGS
		this appeal is scheduled for October 2, 2015 at 10:00 a.m. in courtroom 201. This appeal will have 30 minutes per side for a total argument time of one hour. By: En Banc (Per Curiam). Service as of this date by Clerk of Court. [250265]
		* * * * *
6/23/15	123	CORRECTED AMICUS BRIEF FILED for Hugh C. Hansen [122]. Number of Pages: 16. Service: 06/23/2015 by US mail. [251264]
		* * * * *
7/16/15	128	BRIEF FILED for Appellee Lee [127]. Number of Pages: 46. Service: 07/16/2015 by email. Pursuant to ECF-10, filer is directed to file an original and thirty copies of the brief in paper format. The paper copies of the brief should be received by the court on or before 07/22/2015. Appellant Simon Shiao Tam reply brief is due 08/04/2015. [257227]
		* * * * *
7/23/15	138	AMICUS BRIEF FILED for Richard L. Stanley [134]. Number of Pages: 29. Service: 07/23/2015 by email. Pursuant to ECF-10, filer is directed to file thirty copies of the brief in paper format. The paper

DATE	DOCKET NUMBER	PROCEEDINGS
		copies of the brief should be received by the court on or before 07/29/2015. [259193]
7/23/15	140	AMICUS BRIEF FILED for Fred T. Korematsu Center for Law and Equality, National Asian Pacific American Bar Association and South Asian Bar Association of Washington, D.C. [137]. Number of Pages: 24. Service: 07/23/2015 by email. Pursuant to ECF-10, filer is directed to file thirty copies of the brief in paper format. The paper copies of the brief should be received by the court on or before 07/29/2015. [259206]
7/23/15	148	AMICUS BRIEF FILED for Amanda Blackhorse, Marcus Briggs-Cloud, Phillip Gover, Jillian Pappan and Courtney Tsotigh [132]. Number of Pages: 30. Service: 07/23/2015 by email. [259473]
		* * * * *
8/4/15	150	REPLY BRIEF FILED for Appellant Simon Shiao Tam [149]. Number of Pages: 20. Service: 08/04/2015 by email. Pursuant to ECF-10, filer is directed to file thirty copies of the brief in paper format. The paper copies of the brief should be received by the court on or before 08/10/2015. [262085]

DATE	DOCKET NUMBER	PROCEEDINGS
		* * * * *
8/24/15	153	CORRECTED ENTRY: AMICUS BRIEF FILED for American Civil Liberties Union of Oregon, American Civil Liberties Unition of the Nations's Capital, and ACLU [152]. Pages: 28. Pursuant to ECF-10(D), the filer is directed to submit the approriate number of copies within two days. [266313]—[Edited 09/03/2015 by clerk to correct pdf]
		* * * * *
9/4/15	162	Citation of Supplemental Authority pursuant to Fed. R. App. P. 28(j) for Amicus Curiae Pro-Football, Inc.. Service: 09/04/2015 by email. [269883]
		* * * * *
10/2/15	168	Submitted after ORAL ARGUMENT by Lee Rowland for ACLU, ACLU-NCA and American Civil Liberties Union of Oregon, Ronald D. Coleman, Esq. for Simon Shiao Tam and Daniel Tenny for Lee. Panel: Judge: Prost, Judge: Newman, Judge: Lourie, Judge: Dyk, Judge: Moore, Judge: O'Malley, Judge: Reyna, Judge: Wallach, Judge: Taranto, Judge: Chen,

DATE	DOCKET NUMBER	PROCEEDINGS
		Judge: Hughes, Judge: Stoll. [277118]
12/22/15	169	OPINION and JUDGMENT filed. The judgment or decision is: Vacated and Remanded. (Precedential Opinion). (For the Court: Prost, Chief Judge; Newman, Circuit Judge; Lourie, Circuit Judge; Dyk, Circuit Judge; Moore, Circuit Judge; O'Malley, Circuit Judge; Reyna, Circuit Judge; Wallach, Circuit Judge; Taranto, Circuit Judge; Chen, Circuit Judge; Hughes, Circuit Judge and Stoll, Circuit Judge). Concurring opinion filed by Circuit Judge OMalley, in which Circuit Judge Wallach joins. Opinion concurring in part and dissenting in part filed by Circuit Judge Dyk, in which Circuit Judges Lourie and Reyna join with respect to parts I, II, III, and IV. Dissenting opinion filed by Circuit Judge Lourie. Dissenting opinion filed by Circuit Judge Reyna. [298033]
2/11/16	170	ERRATA to the Precedential Opinion Doc No. [169]. Service as of this date by Clerk of Court. [310201]

DATE	DOCKET NUMBER	PROCEEDINGS
2/12/16	171	Mandate issued to the United States Patent and Trademark Office. Service as of this date by Clerk of Court. [310624]
		* * * * *
4/21/16	173	Petition for writ of Certiorari filed on 04/20/2016 in the Supreme Court of the United States. Supreme Court #: 15-1293, Michelle K. Lee v. Simon Shiao Tam. [328533]
9/29/16	174	The petition for writ of certiorari, [15-1293], filed on 04/20/2016, was Granted on 09/29/2016. [370288]

PTO Form 1478 (Rev 9/2010)
OMB No. 0651-0009 (Exp 12/31/2011)

Trademark/Service Mark Application, Principal Register

TEAS Plus Application

Serial Number: 85472044

Filing Date: 11/14/2011

NOTE: Data fields with the * are mandatory under TEAS Plus. The wording "(if applicable)" appears where the field is only mandatory under the facts of the particular application.

The table below presents the data as entered.

Input Field	Entered
TEAS Plus	**YES**
MARK INFORMATION	
***MARK**	THE SLANTS
***STANDARD CHARACTERS**	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	THE SLANTS
***MARK STATEMENT**	The mark consists of standard characters, without claim to any particular font, style, size, or color.
REGISTER	Principal
APPLICANT INFORMATION	

***OWNER OF MARK**	Tam, Simon Shiao
***STREET**	**[REDACTED]**
***CITY**	**[REDACTED]**
***STATE (Required for U.S. applicants)**	**[REDACTED]**
***COUNTRY**	United States
***ZIP/POSTAL CODE (Required for U.S. applicants only)**	**[REDACTED]**
PHONE	**[REDACTED]**
LEGAL ENTITY INFORMATION	
***TYPE**	INDIVIDUAL
***COUNTRY OF CITIZENSHIP**	United States
GOODS AND/OR SERVICES AND BASIS INFORMATION	
***INTERNATIONAL CLASS**	041
IDENTIFICATION	Entertainment in the nature of live performances by **a musical band**
***FILING BASIS**	SECTION 1(a)
FIRST USE ANYWHERE DATE	At least as early as 11/15/2006
FIRST USE IN COMMERCE DATE	At least as early as 11/15/2006
SPECIMEN FILE	\\TICRS\EXPORT11\IMAGEOUT11\854\720\85472044\

NAME(S)	xm11\FTK0003.JPG
	\\TICRS\EXPORT11\IMAGEOUT11\854\720\85472044\xm11\FTK0004.JPG
	\\TICRS\EXPORT11\IMAGEOUT11\854\720\85472044\xm11\FTK0005.JPG
SPECIMEN DESCRIPTION	Flyers advertising performances
ADDITIONAL STATEMENTS INFORMATION	
*TRANSLATION (if applicable)	
*TRANSLITERATION (if applicable)	
*CLAIMED PRIOR REGISTRATION (if applicable)	
*CONSENT (NAME/LIKENESS) (if applicable)	
*CONCURRENT USE CLAIM (if applicable)	
ATTORNEY INFORMATION	
NAME	Ronald Coleman
FIRM NAME	GOETZ FITZPATRICK LLP
INTERNAL ADDRESS	1 Penn Plaza
STREET	Suite 4401

CITY	New York
STATE	New York
COUNTRY	United States
ZIP/POSTAL CODE	10119
PHONE	2126958100
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AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
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***COUNTRY**	United States
***ZIP/POSTAL CODE**	10119
PHONE	2126958100
***EMAIL ADDRESS**	rcoleman@goetzfitz.com
***AUTHORIZED TO COMMUNICATE VIA EMAIL**	Yes
FEE INFORMATION	

NUMBER OF CLASSES	1
FEE PER CLASS	275
***TOTAL FEE PAID**	275
SIGNATURE INFORMATION	
***SIGNATURE**	/Simon Shiao Tam/
***SIGNATORY'S NAME**	Simon Shiao Tam
***SIGNATORY'S POSITION**	Owner
***DATE SIGNED**	11/14/2011

PTO Form 1478 (Rev 9/2006)
OMB No. 0651-0009 (Exp 12/31/2011)

Trademark/Service Mark Application, Principal Register

TEAS Plus Application

Serial Number: 85472044
Filing Date: 11/14/2011

To the Commissioner for Trademarks:

MARK: THE SLANTS (Standard Characters, see mark)

The literal element of the mark consists of THE SLANTS.

The mark consists of standard characters, without claim to any particular font, style, size, or color.

The applicant, Simon Shiao Tam, a citizen of United States, having an address of

[REDACTED]

requests registration of the trademark/service mark identified above in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.), as amended, for the following:

For specific filing basis information for each item, you must view the display within the Input Table.

International Class 041: Entertainment in the nature of live performances by a musical band

In International Class 041, the mark was first used at least as early as 11/15/2006, and first used in commerce at least as early as 11/15/2006, and is now in use in such commerce. The applicant is submitting one specimen(s) showing the mark as used in commerce on or in connection with any item in the class of listed goods and/or services, consisting of a(n) Flyers advertising performances.

Specimen File1
Specimen File2
Specimen File3

The applicant's current Attorney Information:

Ronald Coleman of GOETZ FITZPATRICK LLP

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New York, New York 10119
United States

The applicant's current Correspondence Information:

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Suite 4401
New York, New York 10119
2126958100(phone)
rcoleman@goetzfitz.com (authorized)

A fee payment in the amount of $275 has been submitted with the application, representing payment for 1 class(es).

Declaration

The undersigned, being hereby warned that willful false statements and the like so made are punishable

by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

Signature: /Simon Shiao Tam/
Date Signed: 11/14/2011
Signatory's Name: Simon Shiao Tam
Signatory's Position: Owner

RAM Sale Number: 4120
RAM Accounting Date: 11/15/2011

Serial Number: 85472044
Internet Transmission Date: Mon Nov 14 16:48:48 EST 2011
TEAS Stamp:
USPTO/FTK-66.251.23.10-20111114164848549373-85472044-4808b9c85f3636e2c33bf8b705e545ba2b7-CC-4120-20111114153506454362

20

THE SLANTS


THE SUNSET PRESENTS SUNDAY BLOODY SUNSET
WITH
THE SUNSET
SEATTLE
SUNDAY MARCH 1ST - 4PM

THE VAGUE PROPHETS

THE SLANTS

THE SUBTERRANEAN HOWL

SUNDAY MAY 24TH 7:00

HIGH DIVE




BURNSIDE
SXSW SHOWCASE
SUBMERGED
WEDNESDAY MARCH 18TH
333 E. SECOND ST.
AT TRINITY
STARRING:
JACKIE BRITTON 8 PM
THE SUMMER WARDROBE 9 PM
THE SERVICE INDUSTRY 10 PM
SWEET WATER 11 PM
BLIND PILOT 12 AM
THE SLANTS 1 AM
SXSW '09
MUSIC
R
www.bddistribution.com
BD

THE SLANTS

Attachment – 159
Attachment – 160
Attachment – 161
Attachment – 162

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

APPLICATION SERIAL NO. 85472044

MARK: THE SLANTS

85472044

CORRESPONDENT ADDRESS:
RONALD COLEMAN
GOETZ FITZPATRICK LLP
1 PENN PLZ STE 4401
NEW YORK, NY 10119-0196

CLICK HERE TO RESPOND TO THIS LETTER:
http://www.uspto.gov/trademarks/teas/response_forms.jsp

APPLICANT: Tam, Simon Shiao

CORRESPONDENT'S REFERENCE/DOCKET NO:
N/A

CORRESPONDENT E-MAIL ADDRESS:
rcoleman@goetzfitz.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE

TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 1/6/2012

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. § 1062(b); 37 C.F.R. §§ 2.62(a), 2.65(a); TMEP §§ 711, 718.03.

SEARCH OF OFFICE'S DATABASE OF MARKS

The trademark examining attorney has searched the Office's database of registered and pending marks and has found no conflicting marks that would bar registration under Trademark Act Section 2(d). TMEP § 704.02; *see* 15 U.S.C. § 1052(d).

SECTION 2(A)—MARK IS DISPARAGING

Registration is refused because the applied-for mark consists of or includes matter which may disparage or bring into contempt or disrepute persons, institutions, beliefs or national symbols. Trademark Act Section 2(a), 15 U.S.C. § 1052(a); *see In re Squaw Valley Dev. Co.*, 80 USPQ2d 1264, 1267-79 (TTAB 2006); *Harjo v. Pro-Football, Inc.*, 50 USPQ2d 1705, 1740-48 (TTAB 1999), *rev'd*, 284 F. Supp. 2d 96, 125, 68 USPQ2d 1225, 1248 (D.D.C. 2003) (finding "no error in the TTAB's articulation of [the Section 2(a)] test for disparagement"), *remanded on other grounds*, 415 F.3d 44, 75 USPQ2d 1525 (D.C. Cir. 2005), *and aff'd*, 565 F.3d 880, 90 USPQ2d 1593 (D.C. Cir. 2009), *cert. denied*, 130 S. Ct. 631 (2009); TMEP §§ 1203.03, 1203.03(c).

The following two factors must be considered when determining whether matter may be disparaging under Trademark Act Section 2(a):

> (1) What is the likely meaning of the matter in question, taking into account not only dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods and/or services, and the manner in which the mark is used in the marketplace in connection with the goods and/or services; and
>
> (2) If that meaning is found to refer to identifiable persons, institutions, beliefs or national symbols, whether that meaning may be disparaging to a substantial composite of the referenced group.

In re Squaw Valley Dev., 80 USPQ2d at 1267 (citing *Harjo*, 50 USPQ2d at 1740-41); TMEP § 1203.03(c).

To "disparage" means "to speak slighting[ly] of: run down: depreciate." *In re Squaw Valley Dev. Co.*, 80 USPQ2d 1264, 1276 (TTAB 2006) (internal punctuation omitted) (quoting *Webster's Third New International Dictionary* (unabridged ed. 1993)). The determination of whether a mark is disparaging depends upon the perspective of the object of disparagement. *In re Lebanese Arak Corp.*, 94 USPQ2d 1215, 1217 (TTAB 2010); *see also* TMEP § 1203.03(c). A mark may be disparaging in two ways:

> (1) Matter that is not, in and of itself, disgusting or otherwise unpleasant, may be applied or combined in such a way that it is offensive to the disparaged party. See, e.g., In re Anti-Communist World Freedom Cong., Inc., 161 USPQ 304, 305 (TTAB 1969) (holding design of an "X" superim-

posed over a hammer and sickle to disparage, and to bring into contempt and disrepute, a national symbol of the U.S.S.R.).; or

(2) Matter may be inherently offensive, and, when directed at a specific individual or entity, may become even more offensive. See, e.g., Greyhound Corp. v. Both Worlds Inc., 6 USPQ2d 1635, 1640 (TTAB 1988) (noting "the offensiveness of [applicant's mark, depicting a defecating dog,] becomes even more objectionable because it makes a statement about opposer itself").

The attached evidence shows the likely meaning of "THE SLANTS" to be a negative term regarding the shape of the eyes of certain persons of Asian descent. *See* attached definitions of "Slant". This refers to "persons of Asian descent" in a disparaging manner because it is an inherently offensive term that has a long history of being used to deride and mock a physical feature of those individuals. *See* Online Etymology Dictionary, Mother Chronicles, "Slant Eyes, Almond Eyes, What's in those Chinese Eyes?".

The term "slants" and the full equivalent "slant-eyes" has long been a derogatory term directed towards those of Asian descent. The etymology of the term suggests that its use became prevalent during the various wars of the 20 century, starting with World War II and increasing in use in the Vietnam war as a term to deride and mock the citizens of the countries at war with the United States and those of Asian descent in general. *See* The Color of Words: An Encyclopaedic Dictionary of Ethnic Bias in the United States.

Since that time, the research of the Office indicates that the term "slants" retains it's offensive and derogatory meaning. Importantly, the oldest and largest Asian American civil rights organization in the United States, the Japanese American Citizens League (JACL), has uissued a publication on hate speech that specially states that the term "slant" is derogatory and should not be used. *See* attached webpage excerpt and literature on hate speech from JACL. Moreover, numerous dictionaries define "slants" or "slant-eyes" as a derogatory or offensive term. *See* attached definitions from, among others, Oxford Dictionary of Modern Slang, American Heritage Dictionary, Online Etymology Dictionary, New Partridge Dictionary of Slang and Unconventional English, The Color of Words: An Encyclopedic Dictionary of Ethnic Bias in the United States, American English Compendium, and Urbandictionary.com. Further, many listings of slang and offensive terms include the word "slants" and its derivatives such as slant-eyes, slanted-eyes, and the pictoral representation as a slur or derogatory. *See* listing of racial slurs from Wikipedia.org, http://gyral.blackshell.com/names.html, http://www.asianjoke.com/others/ethnic_slurs.htm, and www.fact-index.com/list_of_ethnic_slurs.html.

More specifically, the band's name has been found offensive numerous times. First, a band performance and a speaking engagement for the lead singer were cancelled because there had been concerns raised over the name of his band. *See* The Daily Swarn, "Oregon Governor Cancels Asian Band the Slants' Performance at Asian Youth Conference." Second, articles on the band have noted that the name has been controversial and that the band chose the name, in part due to the

history of the term. *See* Northwest Asian Weekly, "Rock band to trademark Office: Our Name is Not Disparaging to Asians", "Shuffled! The Slants". Further, several bloggers and commenters to articles on the band have indicated that they find the term and the applied-for mark offensive, even after extensive dialogue with the applicant. *See* attached blogs and article comments, including BigWOWO and Ben Efsaneyim.

Applicant may have chosen the applied-for mark to be self-deprecating and to attempt tp reappropriate the disparaging term. The lack of a disparaging intent is not dispositive on the issue of Section 2(a) disparagement in the Federal registration analysis. The intent of an applicant to disparage the referenced group is not necessary to find that the mark does, in fact, disparage that group. *In re Lebanese Arak Corp.*, 94 USPQ2d 1215, 1220 (TTAB 2010); *see also In re Anti-Communist World Freedom Cong., Inc.*, 161 USPQ 304, 305 (TTAB 1969) (finding applicant's intent to disparage the referenced group immaterial to the disparagement determination). Further, while applicant may not find the term offensive, applicant does not speak for the entire community of persons of Asian descent and the evidence indicates that there is still a substantial composite of persons who find the term in the applied-for mark offensive.

Please note that the denial of the trademark application does not mean that the applicant must use a different name with its music performances or is otherwise prohibited from using the wording "The Slants" in association with its music. Rather, it is a denial of a federally registered trademark, not the right to use

the words. *See In re Heeb Media LLC*, 89 USPQ2d 1071 (TTAB 2008) (quoting *In re McGinley*, 211 USPQ 668, 672 (CCPA 1981) ("[I]t is clear that the PTO's refusal to register [applicant's] mark does not affect [its] right to use it. No conduct is proscribed. . . . ").

The Office research indicates that the applied-for mark remains disparaging to a substantial composite of Asian-Americans. Accordingly, registration is refused under Section 2(a) as disparaging.

GENERAL INFORMATION

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using TEAS, to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using Trademark Applications and Registrations Retrieval (TARR) at http://tarr.uspto.gov/. Please keep a copy of the complete TARR screen. If TARR shows no change for more than six months, call 1-800-786-9199. For more information on checking status, see http://www.uspto.gov/trademarks/process/status/.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at http://www.uspto.gov/teas/eTEASpageE.htm.

To: Tam, Simon Shiao (rcoleman@goetzfitz.com)
Subject: U.S. TRADEMARK APPLICATION NO. 85472044 - THE SLANTS - N/A
Sent: 6/20/2012 5:32:17 PM
Sent As: ECOM102@USPTO.GOV
Attachments:

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

APPLICATION SERIAL NO. 85472044

MARK: THE SLANTS

85472044

CORRESPONDENT ADDRESS:
RONALD COLEMAN
GOETZ FITZPATRICK LLP
1 PENN PLZ STE 4401
NEW YORK, NY 10119-0196

CLICK HERE TO RESPOND TO THIS LETTER: http://www.uspto.gov/trademarks/teas/response_forms.jsp

APPLICANT: Tam, Simon Shiao

CORRESPONDENT'S REFERENCE/DOCKET NO:
N/A

CORRESPONDENT E-MAIL ADDRESS:
rcoleman@goetzfitz.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 6/20/2012

THIS IS A FINAL ACTION.

This Office action is in response to applicant's communication filed on May 29, 2012.

By way of background, an Office action was issued on January 6, 2012, refusing registration under Section 2(a) as disparaging. Applicant's response argued against the refusal. Applicant's arguments have been considered and are found unpersuasive.

Accordingly, the refusal under Trademark Act Section 2(a) is now made **FINAL** for the reasons set forth below. *See* 15 U.S.C. § 1052(a); 37 C.F.R. § 2.64(a).

SECTION 2(A)—MARK IS DISPARAGING

The refusal of registration because the applied-for mark consists of or includes matter which may disparage or bring into contempt or disrepute persons, institutions, beliefs or national symbols is maintained and made FINAL. Trademark Act Section 2(a), 15 U.S.C. § 1052(a); *see In re Squaw Valley Dev. Co.*, 80 USPQ2d 1264, 1267-79 (TTAB 2006); *Harjo v. Pro-Football, Inc.*, 50 USPQ2d 1705, 1740-48 (TTAB 1999), *rev'd*, 284 F. Supp. 2d 96, 125, 68 USPQ2d 1225, 1248 (D.D.C. 2003) (finding "no error in the TTAB's articulation of [the Section 2(a)] test for disparagement"), *remanded on other grounds*, 415 F.3d 44, 75 USPQ2d 1525 (D.C. Cir. 2005), *and aff'd*, 565 F.3d 880,

90 USPQ2d 1593 (D.C. Cir. 2009), *cert. denied*, 130 S. Ct. 631 (2009); TMEP §§ 1203.03, 1203.03(c).

The thrust of applicant's argument is that the application on its face and four-corners, fails to provide a basis for the conclusion that the likely meaning of the mark is disparaging.[1] *See* Applicant's response brief. Applicant's framing of the question and permissible evidence is misplaced. As is plainly stated in *In re Squaw Valley*, the test looks not only at dictionary definitions, any other elements in the mark, and the nature of the goods/services, but also at **the manner in which the mark is used in the marketplace in connection with the goods and/or services.** *In re Squaw Valley Dev.*, 80 USPQ2d at 1267 (citing *Harjo*, 50 USPQ2d at 1740-41); TMEP § 1203.03(c). Thus, a proper consideration of the application is to determine how the mark would be perceived based upon how it is used in the marketplace. To hold otherwise would be to allow the clever construction of an application to avoid a disparaging finding, resulting in expensive

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[1] Notably, this is not applicant's first time before the United States Patent and Trademark Office seeking registration of the mark THE SLANTS for live musical performances. *See* application under Serial No. 77952263 and selected documents from that file, attached hereto and incorporated by reference. It is worth mentioning that applicant appears to have reversed course on its arguments for registrability, arguing in the prior application that ***because*** the applied-for mark was being used by Asian-Americans as a self-descriptor; it could not be disparaging, while in this case arguing that there is no indication in the application that the mark is in any way associated with Asians or Asian-Americans.

opposition and cancellation proceedings by affected third-parties.[2]

Here, the evidence is uncontested that applicant is a founding member of a band (The Slants) that is self-described as being composed of members of Asian descent. See attachments to first Office action on bands name and makeup (for instance, thelsants.com/about_f.html; www.asianreproter.com/arts/2009/30-slants.htm). Thus, the association of the term SLANTS with those of Asian descent is evidenced by how the applicant uses the mark—as the name of an all Asian-American band. Further, applicant (and his fellow band members) have repeatedly indicated that the name THE SLANTS is in fact a direct reference to the derogatory meaning of the term and in fact, they are embracing the derogatory meaning of the term. One of the members of the band is quoted as stating: "I was trying to think of things that people **associate with Asians**. Obviously, one of the first things people say is that we have slanted eyes. I thought, what a great way to reclaim that stereotype. . . . " *See* Rock Band to Trademark Office: Our Name is Not Disparaging to Asians, NW Asian Weekly (attached to the first Office action). In fact, the evidence shows applicant chose the name THE SLANTS for the band specifically **because** of the Asian connection. *See e.g.*,

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[2] Applicant's argument that the Office is limited to the four-corners of the application in determining the disparaging nature of the mark is too clever by half. Were applicant's theory correct, any smart applicant (or smart attorney) could easily draft an identification of goods and services that skates around any mention of a group or persons associated with a particular term, while at the same time, using the mark in such a way as to associate the mark with the disparaged group.

A Common Ground for a Controversial Band, THE ASIAN REPORT, attached to first Office action ("**For the band, the name was a way to reclaim a racial slur and to assert Asian pride.**") Thus, the evidence is overwhelming that applicant chose the mark fully aware of the connection to the racial slur. There is no evidence of record to indicate that any meaning other than the offensive meaning is applicable to the instant application.

Applicant's other arguments are equally misplaced. Applicant argues that the dictionaries referenced are not "actual" dictionaries. This statement is incredulous on its face. Specialized dictionaries are no less "actual" dictionaries than generalized dictionaries. In fact, many of the dictionaries and reference materials are published by large scale publishing houses, such as Harper Collins. Further, that applicant cleverly chose specimens that avoided associations with Asians or Asian culture is not evidence that the mark is not used in a way to conjure up the derogatory meaning and to be disparaging to Asians. The evidence attached to the first Office action is overwhelming that the applied-for mark is used in connection with an Asian-American band, performing Chinatown Dance music, and that the name was chosen in clear recognition of the offensive meaning of the term in connection with Asians. *See* attachments to First Office action. Further, the evidence shows that the applied-for mark was chosen expressly because of its association with Asians, perhaps in an attempt to reclaim the term. *See e.g.*, Despite Name, Band Aims for Diverse Dance Rock, THE OREGONIAN ("For our band, we're not just Chinese, we're not just Vietnamese, we're kind of a pan Asian band that celebrates

all the different Asian cultures out there. . . . Everyone in the band really loves the fact that we can try and empower Asian Americans and say, 'you know what? We are slant. Who cares? We're proud of that.'").

The evidence of record shows that the likely meaning of the mark, in light not only of the application, but also the "manner in which the mark is used in the marketplace," is the disparaging term regarding the shape of the eyes of certain persons of Asian descent, and that the term remains disparaging to the Asian and Asian-American communities.

Accordingly, the refusal of registration under Section 2(a) is maintained and made FINAL.

RESPONSE OPTIONS TO FINAL OFFICE ACTION

If applicant does not respond within six months of the date of issuance of this final Office action, the application will be abandoned. 15 U.S.C. § 1062(b); 37 C.F.R. § 2.65(a). Applicant may respond to this final Office action by:

(1) Submitting a response that fully satisfies all outstanding requirements, if feasible; and/or

(2) Filing an appeal to the Trademark Trial and Appeal Board, with an appeal fee of $100 per class.

37 C.F.R. §§ 2.6(a)(18), 2.64(a); TBMP ch. 1200; TMEP § 714.04.

In certain rare circumstances, a petition to the Director may be filed pursuant to 37 C.F.R. § 2.63(b)(2) to review a final Office action that is limited to procedural issues. 37 C.F.R. § 2.64(a); TMEP § 714.04; *see* 37 C.F.R. § 2.146(b); TBMP § 1201.05; TMEP § 1704

(explaining petitionable matters). The petition fee is $100. 37 C.F.R. § 2.6(a)(15).

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TEAS PLUS APPLICANTS MUST SUBMIT DOCUMENTS ELECTRONICALLY OR SUBMIT FEE: Applicants who filed their application online using the reduced-fee TEAS Plus application must continue to submit certain documents online using TEAS, including responses to Office actions. *See* 37 C.F.R. § 2.23(a)(1). For a complete list of these documents, see TMEP § 819.02(b). In addition, such applicants must accept correspondence from the Office via e-mail throughout the examination process and must maintain a valid e-mail address. 37 C.F.R. § 2.23(a)(2); TMEP §§ 819, 819.02(a). TEAS Plus applicants who do not meet these requirements must submit an additional fee of $50 per international class of goods and/or services. 37 C.F.R. § 2.6(a)(1)(iv); TMEP § 819.04. In appropriate situations and where all issues can be

resolved by amendment, responding by telephone to authorize an examiner's amendment will not incur this additional fee.

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